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Technology Center 2100
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In re Application of: Li Gong)
Application No. 08/883,636) **DECISION ON PETITION UNDER 37**
Filed: June 26, 1997) **C.F.R. § 1.181(a) TO INVOKE**
For: LAYER-INDEPENDENT SECURITY) **SUPERVISORY AUTHORITY**
FOR COMMUNICATION)
CHANNELS)

This is a decision on a petition, filed 11 April 2001, under 37 C.F.R. § 1.181(a) to invoke Supervisory Authority and require the Examiner to (A) withdraw the rejection based upon Official Notice as set forth in the Office action of mail date August 29, 2000 (B) to withdraw the requirement for labeling Figure 3 as "Prior Art" and (C) provide evidence supporting the Official Notice of the February 13, 2001 Office action.

RECENT PROSECUTION BACKGROUND

- August 29, 2000 - Office action mailed. In the art rejection of claims 2, 6, and 14 the examiner took Official Notice that it is old and well known that encrypting already encrypted data increases security and that encryption is sometimes performed in communication protocols.
- November 29, 2000 - Petitioner files response requesting evidence that the asserted features are old and well known
- February 13, 2001 - Office action mailed. Examiner points out that there has not been an adequate challenge to traverse the Official Notice. Examiner supplies a reference to support the assertions made in the Official Notice.
- Examiner objects to Figure 3 requesting it be "designated with a legend such as -- Prior Art -- "
- Examiner takes Official Notice of various features of Java (¶ 14).
- April 11, 2001 - Petition filed.

RELIEF REQUESTED

The petition under 37 CFR §§ 1.181 requests the following relief:

- A. Requiring the Examiner to further elucidate the rejection of August 29, 2000.
- B. Withdrawal of the Drawing Requirement.
- C. Requiring the Examiner to provide a reference in support of his position as to the noticed features of Java.

OPINION

A. Official Notice of August 29, 2000

On November 29, 2000 Petitioner responded to the Office action of mail date August 29, 2000. On page petitioner states:

The Applicants respectfully traverse the Examiner's Official Notice and assertions. In the absence of a reference teaching the encryption recitations of claims 2, 6, and 14, it is submitted that there is no basis for a conclusion of obviousness under 35 U.S.C. 103. Withdrawal of the rejection is respectfully solicited.

In the petition, Applicant cites MPEP 2144.03 which says : "If the Applicant traverses such an assertion the Examiner should cite a reference in support of his or her position".

MPEP 2144.03 states: "applicant is charged with *rebutting* the well known statement". Challenging the existence of well known prior art by arguing that the fact is not supported by a reference, without stating that the Examiner is wrong or that Applicant is without knowledge of the prior art teaching does not constitute a proper traverse.

Applicant failed to make a reasonable challenge to the Official Notice, and, as a result, the examiner was not required to cite any art. In any event, in response to Applicant, the Examiner cited US Patent No. 5,671,279 to El-Gamal as support.

Petitioner asserts (page 3):

Further, the Examiner's pro forma indication of a reference, *which does not appear to teach anything related to the subject matter* for which the traversal of Official Notice was taken, is not sufficient compliance with MPEP 2144.03. (Emphasis added)

Petitioner is relying on his belief in the inadequacy of the reference as a basis of this petition.

Whether the Examiner has established a *prima facie* case of obviousness and whether the rejections over art are correct are appealable issues not subject to petition. 37 CFR §§ 1.181(a) states:

§ 1.181 Petition to the Commissioner.

(a) Petition may be taken to the Commissioner: (1) From any action or requirement of any examiner in the ex parte prosecution of an application *which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court*; (2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Commissioner; and (3) To invoke the supervisory authority of the Commissioner in appropriate circumstances. For petitions in interferences, see § 1.644. (*Emphasis added*)

Thus, the correctness of the art rejection is not subject to review by Petition.

Accordingly, the Petition is **DENIED**.

B and C. Drawing requirement and Official Notice of February 13, 2001

§ 1.181 Petition to the Commissioner.

(c) When a petition is taken from an action or requirement of an examiner in the ex parte prosecution of an application, **it may be required that there have been a proper request for reconsideration (§ 1.111) and a repeated action by the examiner**. The examiner may be directed by the Commissioner to furnish a written statement, within a specified time, setting forth the reasons for his decision upon the matters averred in the petition, supplying a copy thereof to the petitioner.

No response or request for reconsideration has been filed in the case. Therefore, the petition is premature. Accordingly, the Petition with respect to items **B** and **C** above is **DISMISSED** as **UNTIMELY**.

Any request for reconsideration must be filed within two months of the mailing date of this decision.



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